

Appl. No. : 10/085,169
Filed : February 25, 2002

REMARKS

In response to the Office Action mailed October 18, 2005, Applicants respectfully request the Examiner to reconsider the above-captioned application in view of the following comments. No claims have been amended, canceled or added by this paper. Thus, the listing of claims provided herein is merely for the purpose of convenience.

Equivalency Of Normally Closed Slit and Normally Open Slot Has Not Been Established

Independent Claims 1 and 5 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Lampropoulos in view of Crowley. The Examiner has taken the position that Crowley teaches that normally closed slits and normal open slots are functional equivalents and, thus, it would be obvious to substitute the normally closed slits of Lampropoulos with for a normally open slot of Crowley.

Initially, Applicants note that in order to rely on equivalence as a rationale for supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on the mere fact that the components at issue are functional or mechanical equivalents. See M.P.E.P. § 2144.06 (citing *In re Scott*, 323 F.2d 1016 (CCPA 1963)). Thus, it is not sufficient to show that normally closed slits and normally open slots are functional equivalents. To maintain the rejection, the Examiner must show that the equivalency is recognized in the prior art.

Applicants submit that the mere existence in the Crowley reference of an embodiment including normally open slots and an embodiment including normally closed slits does not establish the equivalency of these features, nor render their substitution for one another prima facie obvious. Clearly, normally open slots and normally closed slits possess significantly different principles of operation. While the normally open slots of Crowley permit fluid flow at any time (with only the direction of flow changing), the normally closed slit of Crowley completely prevents fluid flow under certain conditions (i.e., when the external pressure is greater than the internal pressure within the catheter lumen). Fluid flow is only permitted when the lumen pressure exceeds the external pressure by a sufficient degree to open the slit and, thus, fluid flow is unidirectional. Thus, Applicants submit that the existence of multiple embodiments in Crowley, by itself, does not establish the equivalency of normally open slots and normally closed slits.

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The Proposed Combination Does Not Necessarily Teach All Claim Limitations

For the sake of argument, even if it were obvious to substitute the normally closed slits of Lampropoulos with the normally open slots of Crowley, a prima facie case of obviousness would not be established because the combination fails to suggest that the aggregate flow area of the normally open slots would necessarily be less than the cross-sectional area of the catheter lumen. It is not sufficient that such a feature may result from the proposed combination.

The Examiner has yet to point to any disclosure or suggestion in the prior art to utilize the exit holes of a catheter as a flow restrictor in order to provide a relatively uniform flow rate throughout the length of the infusion section of the catheter. The proposal of replacing the normally closed, variable slits of the Lampropoulos device with normally open slots does not necessarily lead to the conclusion that the normally open slots would be configured such that the aggregate area of the slots is less than the cross-sectional area of the catheter lumen. Without such a disclosure or suggestion, the present rejection of Claims 1 and 5 cannot be maintained. Accordingly, allowance of Claims 1 and 5 is respectfully requested.

Claims 2, 3, 6-8, 11 and 12 depend from one of allowable Claims 1 and 5. These claims are allowable on their own merit as well. Accordingly, allowance of Claims 2, 3, 6-8, 11 and 12 is respectfully requested.

U.S. Patent No. 5,624,392 to Saab

An Office Action mailed April 7, 2006 in related application number 10/104,892 and U.S. Patent No. 5,624,392 have been disclosed to the Office in an information disclosure statement filed herewith.

Although not cited in the outstanding Office Action, U.S. Patent No. 5,624,392 to Saab was cited in related application number 10/104,892 and utilized, in combination with other references, to reject claims pending in the '892 application. In the Office Action mailed April 7, 2006 in the '892 application, the Examiner states that the Saab reference teaches that "the diameter of the cross-sectional area of a lumen may be varied to create different pressure gradients and fluid flow rates." Page 4 of the Office Action mailed April 7, 2006.

Applicants respectfully submit that, even if the Saab reference teaches that pressure and fluid flow rate may vary with the cross-sectional area of a lumen, such a teaching does not

Appl. No. : 10/085,169
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suggest a catheter having, among the other recitations, the claimed relationship between the cross-sectional area of lumen and the combined area of the fluid exit holes. The Saab reference does not disclose that the cross-sectional area of a lumen should have any particular relationship with respect to an exit hole, or collection of exit holes, communication with the lumen. As a result, the Saab reference does not provide any suggestion or motivation to modify the Lampropoulos et al. or Crowley references. Accordingly, Applicants submit that the presently pending claims are allowable over the Saab reference alone, or in combination with any of the prior art of record.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims. Accordingly, early issuance of a Notice of Allowance is most earnestly solicited.

The undersigned has made a good faith effort to respond to all of the rejections in the case. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicant's attorney, Curtiss C. Dosier at (949) 721-7613 (direct line), to resolve such issue promptly.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: April 17, 2006

By: 

Curtiss C. Dosier
Registration No. 46,670
Attorney of Record
Customer No. 20,995
(949) 760-0404

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